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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,215	11/03/2003	Richard G. Sevier	200311063-1	3095
22879 7590 01/02/2009 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER STOREY, WILLIAM C				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
01/02/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/700,215

Applicant(s)

SEVIER, RICHARD G.

Examiner

WILLIAM C. STOREY

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5-10, 20, 24-29, 39 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.5-10, 20, 24-29, 39 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on 4/22/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing
below:

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

3. Claim(s) 39, 50 (and dependents) is/are rejected under 35 U.S.C. 101 because the possibility exists for the claims to be embodied as software, or non-patentable

material. Please establish that the claims are not directed to software, or non-patentable material. When treating each limitation of a claim that appears to be directed to a machine such as a "system", "apparatus", or "arrangement", if the claim is reasonably read on the corresponding software portion of the disclosure, the claim as a whole will be treated as directed to entirely a software embodiment, not a hardware embodiment.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim(s) 39, 50 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 39, 50 defines a system embodying functional descriptive material. However, the claim does not define a "computer-readable medium or computer-readable memory" and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some

computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on "computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory (refer to "note" below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Note:

"A transitory, propagating signal ... is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter." (*In re Petrus A.C.M. Nuijten*; Fed Cir, 2006-1371, 9/20/2007).

Should the full scope of the claim as properly read in light of the disclosure encompass non-statutory subject matter such as a "signal", the claim as a whole would be non-statutory. Should the applicant's specification define or exemplify the computer readable medium or memory (or whatever language applicant chooses to recite a computer readable medium equivalent) as statutory tangible products such as a hard

drive, ROM, RAM, etc, as well as a non-statutory entity such as a "signal", "carrier wave", or "transmission medium", the examiner suggests amending the claim to include the disclosed tangible computer readable storage media, while at the same time excluding the intangible transitory media such as signals, carrier waves, etc.

4. Claim 1 (and dependents) is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the selection method including steps of obtaining, examining, and sending is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "obtaining", "examining" or "sending" to limit the steps to the being performed only by a machine or physical apparatus, and the claim language itself is sufficiently broad to read on an individual obtaining a digital image, mentally examining the digital image, and based on his or her

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

interpretation aligned with the conditionality espoused by the claim language, and personally sending images for some processing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5-8, 20, 24-27, 39, 50 are rejected under 35 U.S.C. 103(a) as being obvious over Connolly (US 6169873).

Regarding claim 1, Connolly discloses scanning that may scan up to two sides, and that analysis of a page's pixels is performed, and that the scanner provides images of the sides of sheets intended for image transfer (fig. 1, col. 5, lines 13-29, lines 54-67). It is well known to those of ordinary skill in the art to obtain digital images from scans for image transfer (obtaining a first digital image of a first side of a physical object (paper)). The physical object is a first of an ordered set of physical objects (fig. 1); examining the first digital image to determine if it is substantially blank (col. 6, lines 28-31. Since a determination is done to see if images appear on one or two sides of first pages, it is inherent that the first digital image be determined if it is substantially blank in this context (col. 5, lines 54-63));

Connolly disclosed that it was well known to check a sheet for face orientation, and then make the assumption for the rest of the sheets in the stack. Connolly disclosed claim 1 (at least a first sheet), col. 2, lines 56-58 ("image sense" may refer to

the face-up/face-down orientation for simplex reproduction, for example). Connolly disclosed checking 3 pages as a preferred embodiment before a determination of a page orientation was made, fig. 2, col. 6, lines 12-67, col. 7, lines 1-20. However, considering the previous disclosures of using a first sheet or inclusive of using a first sheet by signifying (at least a first sheet), it would have been at least obvious to one of ordinary skill in the art at the time the invention was made to provide checking only one sheet for face orientation (image sense), and then making the assumption for the rest of the sheets in the stack for the purpose of increasing speed. The checking of additional pages is an improvement that allows for error reduction and the system could easily be implemented by only checking one page.

if the first side is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects (claim 1, col. 2, lines 56-58, col. 3, lines 42-52, col. 5, lines 41-44, col. 7, lines 5--25, previous discussions. Inherently a stack of sheets is ordered.), and, sending the first set of digital images for processing (col. 7, lines 13-15, claim 1); and if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing (col. 3, lines 42-52, 64-67, fig. 2, col. 6, lines 12-67, col. 7, lines 1-25, and similar to previous discussion for other side).

Although Connolly did not distinctly disclose obtaining the second set of digital images *only* if the first digital image is substantially blank, it would have been obvious to

provide removing the improvement of duplex determination in order that obtaining the second set of digital images occurs *only* if the first digital image is substantially blank for the purpose of allowing the invention to be easier to be less complicated. Connolly discusses simplex having images on one side of the sheet, and duplex having images on both sides of the sheet (col. 1, lines 38-41). Connolly discusses how automatic detection of duplex may not always be desired for a user, and how a feature that would be convenient for someone who intends to automatically detect and copy both sides of a two-sided original may prove to be an inconvenience for someone who wishes to copy only one side. Connolly discuss how, in many cases, the user knows straight away that originals are either simplex, and would not wish for the system to scan for duplex sheets (col. 2, lines 42-45). Connolly discusses how in the cases where the user is certain whether originals are simplex, the user would not wish to wait for the paper handling machine to verify what the user already knows (col. 2, lines 62-65). Connolly teaches that a user may input that all pages are to simplex (previous, col. 6, line 48, 52). If the system looks for all pages to be simplex, it would be at least obvious that when a first page is scanned, if the first side is substantially blank, to check the second side for image data. However, if the first side is not substantially blank, then, of course, the first side would be taken as the side of the simplex page, and the second side would not need to be checked since the pages are simplex (image data on one side). Similarly, if the second side is not substantially blank and the first side was, then, of course, the second side would be taken as the side of the simplex page. A simplex print is known to have image data printed on only one side. It would have been obvious from the

discussion, understanding in the art, and the teachings of Connolly to set the side of the page with image data as the simplex side for obtaining, thus providing greater flexibility, simplicity, and/or speed from the previous discussion.

Regarding claim 5, the claim inherits everything as applied above for claim 1. Connolly discloses that blank images are to be deleted (discarded). It would have been at least obvious to one of ordinary skill at the time the invention was made to provide discarding the first digital image if is substantially blank for the purpose of the output of the scanner not requiring as much space or transmission time.

Regarding claim 6, the claim inherits everything as applied above for claim 1. It was disclosed previously scanning the sheets in order to generate images, thus, reading on the claim.

Regarding claim 7, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of images to be printed, Connolly disclosed col. 5, line 19, line 67, claim 7. It would have been obvious to one of ordinary skill at the time the invention was made to provide sending the not substantially blank side of images to be printed for the purpose of having an extra copy of information in case the first copy gets lost.

Regarding claim 8, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of images to be facsimile transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15. It would have been obvious to one of ordinary skill at the time the invention was made to

provide sending the not substantially blank side of images to be facsimile transmitted for the purpose of having allowing someone far away to see the printed information.

Regarding claim 20, the claim is rejected based upon similar reasoning as applied above for claim 1. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 24, the claim is rejected based upon similar reasoning as applied above for claim 5. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 25, the claim is rejected based upon similar reasoning as applied above for claim 6. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 26, the claim is rejected based upon similar reasoning as applied above for claim 7. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 27, the claim is rejected based upon similar reasoning as applied above for claim 8. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 39, the claim is rejected based upon similar reasoning as applied above for claim 1. The system simply provides structure for the method of claim 1 and is not patently distinct; thus, claim 39 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Connolly discloses a system including a

scanning device (col. 5, lines 13-29) which may read on claimed image manager and content module.

Regarding claim 50, the claim is rejected based upon similar reasoning as applied above for claim 39. The "means for" providing the functions in the claim may be read upon by the system including the scanning device.

7. Claims 9 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claims 1 and/or 20 above, and further in view of Garcia (US Publication Application Publication 2003/0048470).

Regarding claim 9, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending images to be email transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15 which show long distance image data transfer capabilities.

In addition, in a similar field of endeavor, Garcia discloses a multi-function peripheral, including a scanning function. Garcia describes scanning documents to create a digital image of a document and an email function that permits electronic mailing of the digital image, as disclosed in paragraph 29.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing sending images to be email transmitted, as taught by Garcia, for the purpose of allowing someone far away to see the printed information that was scanned by the system.

Regarding claim 28, the claim is rejected based upon similar reasoning as applied above for claim 9. Changing the claim from one category of invention to another does not make the claim patentably distinct.

8. Claims 10 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claims 1 and/or 20 above, and further in view of Okubo (US Patent Application Publication 2005/0200903) and well known prior art (MPEP 2144.03), for further support.

Regarding claim 10, Connolly discloses everything claimed as applied above in claim 1.

However, Connolly did not disclose outputting image data to a computer. In a similar field of endeavor discloses a system that eliminates blank pages from image output. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing outputting data to a computer as taught by Nakano, for the purpose of allowing for more user interaction with the images and the ability to store the images for later use. Further, Okubo discloses that it is conventional that read image data (from a scanner, for example) is stored in an image data file (¶4). Storage of a file may read on claimed archive. Additionally, Okubo discloses that storage of blank page image data is wasteful (¶6), and Okubo discloses eliminating blank image data, thus leaving only the image data of a non-blank page to be stored from the sides of a sheet (¶13, 15, 47). Considering this,

and the previous discussions, it would have been at least obvious to provide storage/archival of the output image file in context for the purpose of allowing for greater flexibility and/or insurance. For example, more copies could be produced later, the storage could act as a backup copy, etc.

Nonetheless, for further support, the examiner takes official notice of the fact that it was well known in the art to provide archival of a file.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previous disclosures by specifically providing archival of the image file, for the purpose of providing the benefits mentioned above.

Regarding claim 29, the claim is rejected based upon similar reasoning as applied above for claim 10. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Response to Arguments

9. Applicant's arguments with respect to claims 10 & 29 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 10/8/2008 have been fully considered but they are not persuasive.

Regarding the discussion for claim 1 (and similarly-limited and dependent claims), as previously discussed, the argument that because Connolly describes double-sided determination, no obvious modification could be made as discussed, is not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/
Examiner, Art Unit 2625

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